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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,182	04/16/2004	David M. Brickman	9575-012-23	8293
22852	7590	02/14/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER	
			MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
			3692	
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			02/14/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/825,182

**Applicant(s)**

BRICKMAN ET AL.

**Examiner**

SHAHID R. MERCHANT

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Status of the Claims***

1. This action is in response to the amendment filed on December 4, 2007. Claims 1-27 are pending. Claims 13 and 25 have been amended.

***Response to Arguments***

2. Applicant's arguments filed December 4, 2007 regarding claims 2 and 14 have been fully considered but they are not persuasive. Applicant argues that they are not aware of any rule that requires them to define variables as they appear in formulas or to avoid defining variables that are not recited in the formula. Examiner disagrees. One of ordinary skill in the art would not know how to use the formula as recited and defined in the claims. For example, Applicant recites that formula  $G_i$  is based on a performance index  $PI_i$ , a price reset frequency and a performance measurement  $PM_i$ . Since these variables do not appear in the guarantee fee formula, one of ordinary skill in the art would not know how to use or apply these variables, performance index  $PI_i$ , a price reset frequency and a performance measurement  $PM_i$ , in the guarantee formula since they are not in the formula. In addition, a price reset frequency is not defined or used in any formula listed in the claims.

3. Applicant's arguments filed December 4, 2007 regarding claims 12 and 24 have been fully considered but they are not persuasive. Applicant argues that one of ordinary skill in the art at the time of the invention would have readily understood the "assets having insufficient data...model". Examiner disagrees. The term "insufficient" in claims 12 and 14 is a relative term which renders the claim indefinite. The term "insufficient" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, some statisticians could utilize five data points to generate a robust predictor model while other statisticians might require one million data points to generate a robust predictor model.

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4. Applicant's arguments, see page 15-16, filed December 4, 2007, with respect to claim 25 have been fully considered and are persuasive. The rejection under 35 U.S.C. § 112 2<sup>nd</sup> paragraph has been withdrawn.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 13 and 25 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Applicant has failed to set a base guarantee fee. One of ordinary skill in the art would not be able to reset a guarantee fee if a base or initial guarantee fee has not been set or established. Identifying a manner of securing is not the same as setting a guarantee fee.

8. Regarding claims 2 and 14, performance index  $PI_i$ , price reset frequency, performance measurement  $PM_i$  are said to be parameters of the formula,  $G_i = \text{Min} [\text{Max} (G_0 + PPA_i + TPA_i, \text{MinG}), \text{MaxG}]$  however, they are not recited in the formula. Applicant should define variables as they appear in formulas and avoid defining variables that are not recited in the formula. Appropriate correction is required.

9. Claims 10 and 22 recites the limitation "the manner of securing future guarantee fee..." in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

10. The term "insufficient" in claims 12 and 24 is a relative term which renders the claim indefinite. The term "insufficient" is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

11. Claims 2-12, 14-24 and 26-27 rejected to as being dependent upon a rejected base claim.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 13 and 25 rejected under 35 U.S.C. 102(e) as being anticipated by Oppenheimer et al., U.S. Patent Application Publication 2004/0128230 (see PTO-892, Ref. A).

14. As per claim 1, Oppenheimer teaches the method of structuring a performance-based participation certificate contract, comprising the steps of:

identifying a pool of assets;

identifying parameters for the assets;

identifying a manner of securing a guarantee fee for the contract;

issuing a security reflecting the parameters of the assets; and

resetting the guarantee fee for the security, based on realized performance of the assets, once every predetermined time period (see paragraphs 4, 24, 31, 51, 52 and 104).

15. Claims 13 and 25 recites similar limitations to claim 1 and thus rejected using the same art and rationale in the rejection of claim 1 as set forth above.

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***Allowable Subject Matter***

16. Claim 2, 14, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

/Kambiz Abdi/  
Supervisory Patent Examiner, Art Unit  
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